REMARKS/ARGUMENTS

Claims 1, 6, 18, 19 and 24-27 are pending in the above-captioned patent application. Claims 2-5, 7-17 and 20-23 have been canceled without prejudice or disclaimer of the subject matter they contain. Claims 1, 6, 18 and 19 are amended and claims 24-27 are added to encompass infringing subject matter. The phrase "devoid of pyrethrum" has been added to the claims. Support for this amendment can be found in the specification at, *inter alia*, page 3, lines 22-25 and page 6, line 11. No new matter is added. Applicant reserves the right to file continuing applications for disclosed subject matter not encompassed by the pending claims.

Applicant is grateful for the courtesies extended to himself and the undersigned attorney during the personal interview with Examiner Levy, which was conducted on October 9, 2003.

The Office Action states that claims 20-23 stand withdrawn from consideration pursuant to 37 C.F.R. 1.142(b) as being drawn to a non-elected species. In response, claims 20-23 have are canceled in view of the election of species requirement.

The Office Action rejects claims 6 and 13 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant respectfully traverses this rejection to the extent it applies to the currently pending claims.

The enablement requirement does not require an inventor to meet lofty standards for success in the commercial marketplace. Title 35 does not require that a patent disclosure enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect. Title 35 requires only that the inventor enable one of skill in the art to make and use the claimed invention. The artisan's knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art. *See*

Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1366 (Fed. Cir. 1997) ("[A] specification need not disclose what is well known in the art."); see also *Wands*, 858 F.2d at 736-37 ("Enablement is not precluded by some experimentation, such as routine screening.").

Here, the rejected claims recite a method for killing or controlling pests, comprising: applying to a locus where killing or control of pests is desired an effective amount of the pesticidal composition of claim 1. The written description enables the claimed method by showing how to make the recited pesticidal compositions and by providing working examples that show how use them. *See, e.g., Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1533 (Fed. Cir. 1991) ("The enablement requirement is met if the description enables any mode of making and using the claimed invention."). Applicant respectfully submits that one of skill in the art could readily practice the claimed method with only routine experimentation. The level of disclosure necessary to satisfy 35 U.S.C, § 112, first paragraph, is satisfied. *Durel Corp. v. Osram Sylvania Inc.*, 256 F.3d 1298, 1306-07 (Fed. Cir. 2001); *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). "Patents are not production documents, and nothing in the patent law requires that a patentee must disclose data on how to mass-produce the invented product. . . . [T]he law requires that patents disclose inventions, not mass-production data, and that patents enable the practice of inventions, not the organization and operation of factories." *Christianson v. Colt Indus. Operating Corp.*, 822 F.2d 1544, 1562 (Fed. Cir. 1987).

Further, the written description provides working examples that describe methods for validating and testing the effects of the recited compositions. Using these specific procedures, a skilled artisan would systematically validate the pesticidal activity of the recited compositions. The specification need not eliminate all experimentation. The degree of investigation described

above is not beyond the skill of practitioners in the art, in view of the disclosure in the specification. Such routine validation is not beyond the level of skill for skilled practitioners in the pesticide art and does not constitute undue experimentation. *See Ex parte Forman*, 230 U.S.P.Q. 546 (Bd. Pat. App. & Int. 1986). Indeed, the working examples in the written description provide ample evidence that the claimed method is operative for killing and controlling pests. Applicant is not claiming an impossible result or an inoperative invention. A skilled artisan could readily determine and apply pesticidally-effective amounts of the pesticidal composition recited in claim 1 to a locus where killing or control of pests is desired. The Office Action simply has not provided any probative evidence showing that the rejected claims are inoperable. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Office Action rejects claims 1, 6, 7, 13, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Casida (1973) and Lover et al. (U.S. Pat. No. 4,368,207) or Bessette (WO 98154971) in view of Herrera et al. (U.S. Pat. No. 4,195,080). Applicant respectfully traverses this rejection to the extent it applies to currently pending claims.

Casida essentially teaches away from the claimed invention. Casida merely discloses the use of pyrethrum extracts in combination with synergists. Casida does not disclose a composition devoid of pyrethrum, let alone a method for using a composition devoid of pyrethrum.

Lover fails to remedy the deficiencies of Casida. Lover merely discloses the use of certain higher alcohols as toxicants for lice and/or their ova and to toxicant compositions containing such higher alcohols. Lover nowhere discloses compositions containing the enzyme inhibitors and plant essential oils required by the claimed invention.

Bessette merely discloses methods for using plant essential oil compounds as affector agents against the neurotransmitters of insects. Bessette nowhere discloses or suggests the use of plant essential oils in combination with enzyme inhibitors, as claimed.

Herrera merely discloses a composition comprising citrus juice essence oils as the active ingredient, pyrethrum and PBO. Herrera does not disclose a composition devoid of pyrethrum and comprising the plant essential oils or enzyme inhibitors recited in the pending claims.

Thus, alone or improperly combined, the applied reference do not teach or suggest the features required by the claims. Applicant respectfully requests reconsideration and withdrawal of this rejection.

CONCLUSION

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner's Amendment), the please contact the undersigned attorney at the telephone number listed below.

Please grant any extensions of time deemed necessary. The Commissioner is hereby authorized to charge any deficiency in the small-entity fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. **14-1140**.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 872-9306 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C., 20231.

Date: March 2, 2004

By: _____
Willem F. Gadiano, Registration No. 37,136